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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,799	08/17/2005	Paul Beswick	PG4893USW	7090

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EXAMINER

MORRIS, PATRICIA L

ART UNIT	PAPER NUMBER
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1625

MAIL DATE	DELIVERY MODE
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06/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,799

Applicant(s)

BESWICK ET AL.

Examiner

Patricia L. Morris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8,11,14,17-19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) 7,11,19,21-23,25 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14,17 and 18 is/are rejected.
- 7) ☒ Claim(s) 1-4,6,8 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4, 6, 8, 14, 17, 18, and 24 are under consideration in this application.

Claims 7, 11, 19, 21-23, 25 and 26 remain held withdrawn as being drawn to nonelected subject matter 37 CFR 1.142(b). In view of applicants' amendments to claim 25, claims 25 and 26 are no longer readable on the elected method of use.

Election/Restrictions

Applicants merely allege that the treatment of all the numerous diseases are mediated by Cox-2 is a special technical feature. The diseases listed in the specification are not known to share a common mechanism or pathway.

The requirement is still deemed sound and proper and is therefore made **FINAL**.

Again, this application has been examined in regard to the elected compounds wherein X is oxygen or NR², Y is CH, R¹, R² and B represent non-heterocyclic containing groups, A is (optionally substituted) aryl and R³, R⁶–R¹⁰ and n as set forth in claim 1 exclusively. Claim 25 has been examined to the extent readable on the elected method, *i.e.*, rheumatoid arthritis and osteoarthritis. Applicants have failed to present an independent claim to the **elected method**.

The method claims will not be rejoined at this time because applicants have **failed to limit the claims to the elected products**. Further, applicants are reminded that any rejoined method claims, to be **allowable**, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. In the instant case, none of the withdrawn claims meet all the criteria for patentability and are not allowable. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not

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commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is *presented prior to* final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14, 17 and 18 now depend on a withdrawn claim. Further, claims 17 and 18 lack antecedent basis because withdrawn claim 11 does not recite the **elected method, i.e., *rheumatoid arthritis and osteoarthritis***. Further, there is no basis for COX-2 in claims 17 and 18.

Allowable Subject Matter

Claims 1-3 and 6 are objected to as containing nonelected subject matter. The objection may be overcome by limiting the claim to the subject matter indicated as being examinable, *supra*. A claim so limited would appear allowable.

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Claims 4, 8 and 24 presented in independent form or made dependent on an allowable claim, would appear allowable, otherwise it is objected to as being dependent on a non allowed claim.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

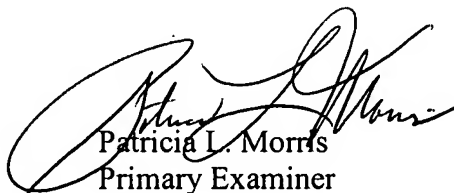
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patricia L. Morris
Primary Examiner
Art Unit 1625

plm
June 18, 2007